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Anastasia Heffner

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In.re Appln. of: David et al.

Appln. No.: 09/851,849

Filed: May 9, 2001

For: Router Apparatus

Attorney Docket No: 10420/12

Examiner: Erica E. Cadugan

Art Unit: 3722

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL

Sir:

Attached is/are:

- ☒ Transmittal Letter (in duplicate); Reply Brief
- ☒ Return Receipt Postcard

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- ☒ No additional fee is required.
- ☐ Small Entity.
- ☐ An extension fee in an amount of \$_____ for a _____-month extension of time under 37 C.F.R. § 1.136(a).
- ☐ A petition or processing fee in an amount of \$_____ under 37 C.F.R. § 1.17(_____).
- ☐ An additional filing fee has been calculated as shown below:

					Small Entity			Not a Small Entity	
	Claims Remaining After Amendment		Highest No. Previously Paid For	Present Extra	Rate	Add'l Fee	or	Rate	Add'l Fee
Total		Minus			x \$25=			x \$50=	
Indep.		Minus			x 100=			x \$200=	
First Presentation of Multiple Dep. Claim					+\$180=			+ \$360=	
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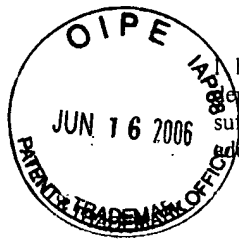
- ☐ A check in the amount of \$_____ is enclosed.
- ☐ Please charge Deposit Account No. 23-1925 in the amount of \$_____. A copy of this Transmittal is enclosed for this purpose.
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- ☒ The Director is hereby authorized to charge payment of any additional filing fees required under 37-CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

6-14-06

Date

Respectfully submitted,

Anastasia Heffner
Anastasia Heffner (Reg. No. 47,638)



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Case No. 10420/12

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

David et al.

Serial No.: 09/851,849

Filed: May 9, 2001

For: Router Apparatus

Examiner: Erica E. Cadugan

Group Art Unit: 3722

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is in response to the Examiner's Answer, filed April 14, 2006.

REPLY TO EXAMINER'S ANSWER

Appellants have chosen to address selected particular points of the Examiner's Answer, as many of the Examiner's arguments repeat the final rejections and thus are addressed in Appellants' Supplemental Appeal Brief. Therefore, the lack of a specific response to a point raised in the Examiner's Answer is not a concession of the rejection. Rather, Appellants' position may be found in its Supplemental Appeal Brief filed on January 27, 2006.

A. The Examiner has failed to show that Glover or Hunt teaches or suggests a guide fastened to sheet metal by fasteners drilled through the sheet metal

The Examiner has rejected independent claims 1, 12, 21, 22 and 24 under 35 U.S.C. §103(a) over Glover. The Examiner also has rejected independent claim 12 under § 103(a) over Hunt. The Examiner's Answer contains fundamental errors relating to the Examiner's construction of the cited references by importing additional limitations into the references that nowhere are disclosed or suggested. As explained further below, § 103(a) requires that the Examiner establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Such a rejection, however, cannot be based on unsupported conjecture that it would be "obvious to try" and recreate the claims of an applicant's invention. 837 F.2d at 1074, 5 U.S.P.Q. 2d at 1598. Such a recreation of the claims, without any teaching or suggestion in the references, constitutes impermissible hindsight, which cannot support an obviousness rejection. 837 F.2d at 1075, 5 U.S.P.Q. 2d at 1600. That is exactly what the Examiner has done here: the Examiner claims, without underlying support, that it would be obvious modify the invention of a reference to include the missing limitation(s) found in the Appellants' claims.

As the Examiner concedes, neither reference teaches that the fasteners extend completely through the workpiece (Examiner's Answer, pp. 5, 7). Instead, the Examiner justifies the rejection by creating a hypothetical to show that Glover and Hunt suggest such a teaching. Specifically, the Examiner engages in conjecture and creates a scenario, not taught in either reference, where the material of Glover or Hunt is of a thickness less than the length

of a fastener, thus causing the fastener to penetrate the workpiece (see e.g., Examiner's Answer, p. 8). The Examiner, however, cannot show that a reference suggests a limitation by engaging in conjecture. The fact is, neither Glover nor Hunt teaches or suggests using a workpiece of a thickness so that the fasteners can extend through, and the Examiner admits that Glover and Hunt are silent as to the thickness of the workpiece (see Examiner's Answer, pp. 5, 7). Instead, the Examiner has engaged in impermissible hindsight by using a hypothetical to recreate the claims of Appellants' application, without having pointed to any specific teaching or suggestion in the prior art. Such hindsight cannot support an obviousness-type rejection.

The only disclosure the Examiner points to is the general statements in Glover and Hunt that the respective devices may be used with a variety of different workpieces (Examiner's Answer, pp. 5, 7). These teachings, however, refer to the types of parts found on an airplane, such as an airplane wing (see e.g., Grover, col. 3, lns. 25-29). The teachings do not refer to the thickness, composition, or other structure of the workpiece, and thus do not provide any suggestion of using a workpiece of a thickness so that the fasteners extend through.

Lacking a basis in the prior art, the Examiner supports the rejection by claiming that using a workpiece of a thickness so that the fasteners would extend completely through would have been an obvious design choice. Specifically, the Examiner states that because Appellants have not discussed the advantage of having the fasteners extend through the workpiece, and have not shown that the functionality of the Appellants' invention would be affected, the use of fasteners extending through the workpiece must be an obvious design choice (see e.g., Examiner's Answer, p. 8). Such circular reasoning fails for several reasons: first, an Examiner cannot rely on the Appellants' disclosure to meet his burden of proving a *prima facie* case of obviousness.¹ See *In re Dance*, 160 F.3d 1339, 1343, 48 U.S.P.Q. 2d 1635, 1637 (Fed. Cir. 1998) ("it is the prior art itself, and not the applicant's achievement, that must establish the obviousness of the combination"). Second, such a statement is akin to claiming that it would be "obvious to try" to create the claims of Appellants' invention, which is impermissible. 837 F.2d at 1074, 5 U.S.P.Q. 2d at 1598. Here, the Examiner states

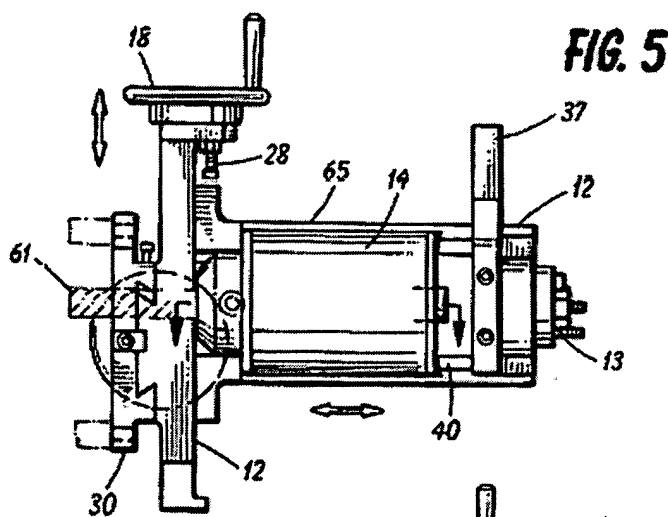
¹ Moreover, the Examiner has not rejected the claims or otherwise objected to the specification as having an insufficient disclosure under 35 U.S.C. § 112, which would be the proper rejection for any perceived deficiencies with the disclosure.

that since the inventions of Glover and Hunt would not be affected if the thickness of the workpiece was changed so that the fasteners could extend through (without ever showing that this statement is correct), it must be an obvious design choice (see Examiner's Answer, pp. 19, 34). Such conjecture cannot form the basis of the Examiner's *prima facie* case.

Accordingly, Appellants respectfully submit that independent claims 1, 12, 22 and 24 are distinguishable from Glover and Hunt and contain allowable subject matter. Dependent claims 1-11, 13-21, 22 and 24 depend from claims 1, 12, 22 and 24, respectively, and are allowable for this same reason and for the additional reasons provided in Appellants' Supplemental Appeal Brief.

B. The Examiner has failed to show that Glover or Hunt teaches or suggests a bearing

The Examiner has rejected claim 20 under 35 U.S.C. § 103(a) over Glover and Hunt, claiming that the references each teach the claimed "bearing." The Examiner claims that Glover teaches the claimed "bearing" via the disclosure of the male dovetail member protruding from the moveable platform 12 that mates with the guide 30 (Examiner's Answer, pp. 27-28). This is incorrect. The dovetail member is not a bearing. Figure 8 of Glover is reproduced below, and shows the mating arrangement between the platform, which includes the dovetail member shown within the circled portion, and guide 30.

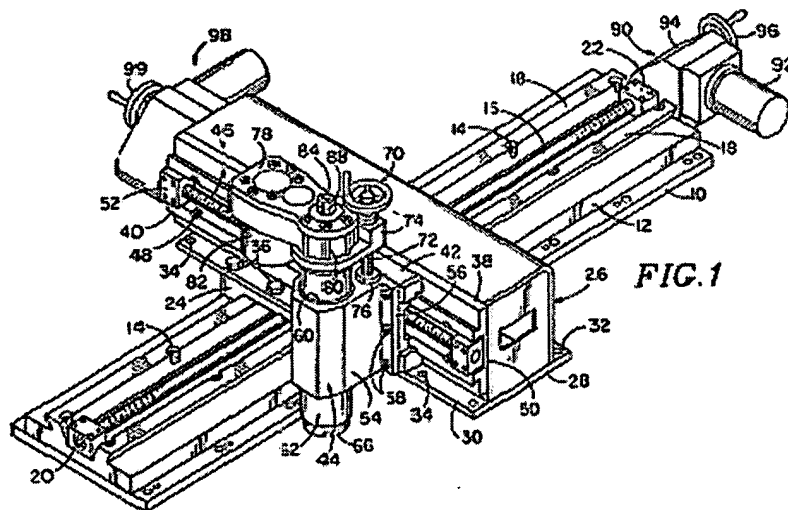


As the Appellants explain in their Appeal Brief, the moveable platform 12, which, as the Examiner concedes, includes the dovetail member, along with the guide 30 acts akin to

the track or guide 62 and platform 64 of Appellants' invention (see Appellants' Application, Figure 8). As taught by the specification, the bearing moves and acts independently of the platform (Appellants' Application, p. 6, lns. 15-26). See *Phillips v. AWH Corp.*, 415 F.3d 1315, 75 U.S.P.Q.2d 1321, 1327 (Fed. Cir. 2005) (the specification is the best guide to interpreting the claims). The bearing of Appellants' invention is an additional component that acts independently of the platform, and, when interacting with the guide, allows the bearing to help with easy maneuvering of the platform along the guide (Appellants' Application, p. 6, lns. 15-17).

On the other hand, and as shown below in Figure 5 from Glover, since the dovetail member (shown within the circled portion) of Glover is part of the platform 12, it moves with the platform 12 and, unlike the Appellants' invention, is not additional structure that is moveable with respect to the platform 12 to help facilitate movement along the guide 30. Using the Examiner's definition, the dovetail member is not a "machine part in which another part ... turns or slides" (see Examiner's Answer, p. 29). Instead, the dovetail member is part of the guide, and moves with the guide, acting akin to the platform of Appellants' invention.

Similarly, Hunt does not disclose a "bearing" that is structure that acts independently of the guide portion 18. As the Examiner concedes, and as shown in Figure 1 of the Hunt patent, reproduced below, the carriage block 24 of Hunt is mounted to the member 26 via bolts 36 (Examiner's Answer, p. 36).



The carriage block does not move independently of the member 26 to help facilitate easy movement between the guide portion 18 and member 26. Simply put, the carriage block 24 is not a “bearing” as that term is normally understood or in accordance with the definition provided by the Examiner.

Accordingly, Appellants request the Board to reverse the rejection under 35 U.S.C. § 103(a) of claim 20 over Glover and Hunt.

C. The Examiner has failed to show that Glover or Hunt teaches or suggests that the guide is a plastic material formed to a uniform height and width

The Examiner goes into great detail to justify sustaining a rejection based upon an obvious design choice, and directly addresses why she believes certain limitations are obvious design choices (Examiner’s Answer, pp. 37-39). The Examiner, however, is silent as to why the guide being plastic would be an obvious design choice, especially in view of the failure to point to any teaching or suggestions in the prior art to do so.

Moreover, contrary to the Examiner’s assertions, Appellants are not claiming that “design choice” rejections are always improper (*see* Examiner’s Answer, p. 38). Instead, Appellants assert that “design choice” rejections are improper when they are based on hindsight without any underlying support. *In re Fine*, 5 U.S.P.Q. 2d at 1598, 1600. The Examiner cannot show a prima facie case of obviousness through unsupported conjecture without any teaching or suggestion in the references. *In re Fine*, 5 USPQ2d at 1600.

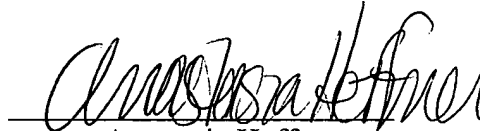
Accordingly, Appellants request the Board to reverse the rejection under 35 U.S.C. § 103(a) of claim 19 over Glover and Hunt.

CONCLUSION

Contrary to the Examiner's arguments set forth in the Examiner's Answer, it is respectfully submitted that the cited references do not teach the structure that is present in Appellants' claims, thus failing to teach each and every element of those claims. Appellants further submit that the present invention is fully patentable over the cited reference and thus, the Examiner's rejection should be REVERSED.

Respectfully submitted,

Dated: June 14, 2006



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